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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,212	11/06/2003	Steve Davis	16222U-016100US	2931

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/705,212

Applicant(s)

DAVIS, STEVE

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Declaration Under 37 C.F.R. § 1.131

1. The Declaration filed on January 3, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Sunder et al. reference.
2. Applicant directs the Examiner to a Declaration filed under 37 C.F.R § 1.131 along with evidence demonstrating Applicant arrived at his invention prior to filing date of the Sunder et al. invention. The Examiner respectfully submits that the documents submitted by the Applicant indicate that conception of the invention occurred before June 2003. However, Applicant has failed to provide specific evidence that he worked diligently from the date of conception until an actual reduction to practice date, or that he worked diligently prior to June 5, 2003 (constructive reduction to practice for the Sunder et al. reference) until November 10, 2003.

MPEP § 2138.06 states the following:

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964)(statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (*Diligence requires that applicants must be specific as to dates and facts.*) (*Emphasis added*)

The declaration includes Exhibit A- a copy of a technical specification entitled "3-D Secure Business Requirements and Technical Approach – VisaGold Version 1.0", thereby alleging diligence in reduction to practice of the instant invention. However, the evidence submitted by the Applicant does not account for any of the time lapses indicated by the date of the specification (May 12, 2003) to the date of the Sunder reference (filed June 5, 2003). Notice, "a

Art Unit: 3621

2-day period lacking activity has been held to be fatal” (see above). As such, it is submitted that the Applicant has failed to provide evidence to fully account for the time period during which due diligence must be established.

3. Claims 1-31 have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 10 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Publication No. 2005/0021781 to Sunder et al.

Referring to claim 1, Sunder et al. disclose receive an authentication request from a cardholder system (i.e. client device)(see paragraphs [0005] & [0007]), forward the authentication request to an access control server (see paragraph [0008]), relay authentication information between the access control server and the cardholder system receive an authentication response from the access control server and forward the authentication response to the cardholder system (see paragraphs [[0010] & [0011]).

Claims 10 and 19 are rejected on the same rationale as claim 1 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 9, 11, 12, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder et al. as applied to claims 1 and 10 above, and further in view of US Publication No. 2003/0046541 to Gerdes et al.

Referring to claim 2, Sunder et al. disclose an electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose the authentication response is adapted to be analyzed by a merchant system. Gerdes et al. disclose the authentication response is adapted to be analyzed by a merchant system (see paragraph [0014] – the authentication server sends a confirmation of the user identity to the service provider. Based on the confirmation, the service provider finally grants service access to the user). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to allow the merchant system to analyze the authentication response. One of ordinary skill in the art would have been motivated to do this because it provides authentication of a user to a service provider (see paragraph [0010] of Gerdes et al.).

Referring to claim 3, Sunder et al. disclose an electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose wherein the central transaction server is adapted to forward a copy of the authentication response to an

Art Unit: 3621

authentication history server to be archived. Gerdes et al. disclose the central transaction server is adapted to forward a copy of the authentication response to an authentication history server to be archived (see paragraph [0057]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include a copy of the authentication response to an authentication history server. One of ordinary skill in the art would have been motivated to do this because it provides a history of authentication transaction (see paragraph [0057] of Gerdes et al.).

Referring to claim 9, Sunder et al. disclose the electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose the central transaction server is adapted to initiate a charge request via a card association network in response to receiving an authentication response from the access control server. Gerdes et al. disclose the central transaction server is adapted to initiate a charge request via a card association network in response to receiving an authentication response from the access control server (see paragraph [0014]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include the central transaction server is adapted to initiate a charge request via a card association network in response to receiving an authentication response from the access control server. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

Claims 11 and 20 are rejected on the same rationale as claim 2 above.

Claims 12 and 21 are rejected on the same rationale as claim 3 above.

Claims 18 and 27 are rejected on the same rationale as claim 9 above.

Art Unit: 3621

8. Claims 4-6, 13-15, 22-24, and 28 -31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder et al. as applied to claims 1, 10 and 14 above, and further in view of US Publication No. 2004/0254848 to Golan et al.

Referring to claims 4 and 5, Sunder et al. disclose the electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server. Golan et al. disclose wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include the system wherein the central transaction server is further adapted receive a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

Referring to claim 6, Sunder et al. disclose the electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. Golan et al. disclose the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request (see paragraphs [0099] & [0100]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include the system wherein the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

Claims 13, 22, 28, and 30 are rejected on the same rationale as claim 4 above.

Claims 14 and 23 are rejected on the same rationale as claim 5 above.

Claims 15 and 24 are rejected on the same rationale as claims 6 above.

Referring to claims 29 and 31, Sunder et al. disclose the electronic commerce card authentication system (see claims 28 and 30 respectively above). Sunder et al. do not expressly disclose modifying the verifying enrollment request from a directory server, and forwarding the modified verifying enrollment response to the directory server. Golan et al. disclose receiving a

Art Unit: 3621

verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). Golan et al. do not teach the request being modified; however, the concept of modifying data is well known in the art of data processing. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include the steps of disclose receiving a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

9. Claims 7, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder et al. as applied to claims 1, 10 and 19 above, and further in view of US Publication No. 2001/0029496 to Otto et al.

Referring to claim 7, Sunder et al. disclose the electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose the authentication request includes a pseudonym corresponding to an electronic commerce card account number and previously created by the central transaction server (see paragraph [0027] – [0029] –the user can submit the anonymous identifying information to the merchant; the merchant submits the request the banking network who then forwards the request to the financial institution that issued the anonymous card). At the time the invention was made, it would have been obvious to a person

Art Unit: 3621

of ordinary skill in the art to modify the system disclose by Sunder to include a pseudonym corresponding the an electronic commerce card account number in the authentication request, the pseudonym previously created by the central transaction server. One of ordinary skill in the art would have been motivated to do this because it secures user's identity by providing a means for users to anonymously purchase goods and services over a network (see Otto et al. paragraph [0007]).

Claims 16 and 25 are rejected on the same rationale as claim 7 above.

10. Claims 8, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder et al. as applied to claims 1, 10 and 19 above, and further in view of US Publication No. 2002/0116341 to Hogan et al.

Referring to claim 8, Sunder et al. disclose the electronic commerce card authentication system (see claim 1 above). Sunder et al. do not expressly disclose the authentication request includes a pseudonym previously created by a merchant system that corresponds to an electronic commerce card account number. Hogan et al. disclose the authentication request includes a pseudonym previously created by a merchant system that corresponds to an electronic commerce card account number (see paragraph [0025]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder et al. to include a pseudonym previously created by the central transaction server. One of ordinary skill in the art would have been motivated to do this because it protects messages and information being transmitted during a transaction (see Hogan et al. paragraph [0016]).

Claims 17 and 26 are rejected on the same rationale as claim 8 above.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jaltee Worjloh
Primary Examiner
Art Unit 3621

March 19, 2007